

Appl. No. 09/676,722  
Amendment dated November 12, 2003  
Reply to Office action of October 8, 2003

### **REMARKS**

Claims 1-34 are pending in the instant application. Claims 1, 8-10, 12-15, and 22 have been amended. Applicant requests reconsideration of the claims in view of the amendments and the following remarks.

Applicant acknowledges with appreciation the Examiner's allowance of claims 8-14, and the Examiner's statement that claims 2 and 17 would be allowable if rewritten in independent form including all of the limitations of the base claims and any intervening claims.

Claims 22-23 presently stand rejected under 35 U.S.C. § 102(e) as being anticipated by Taenzer et al., U.S. Patent No. 6,009,183 (herein after, Taenzer). Claims 1, 3-7, 15-16, and 18-21 presently stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Taenzer. In addition claims 1 and 22 presently stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Schiess, application No. 648172 (herein after, Schiess). Applicant respectfully traverses these rejections.

#### **Anticipation Rejection of Claims 22-23 under 35 U.S.C. § 102(e) – Taenzer et al.**

With regard to an anticipation rejection, MPEP 2131 states that “[a] claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631 2 USPQ2d 1051, 1053 (Fed.Cir. 1987).

Appl. No. 09/676,722  
Amendment dated November 12, 2003  
Reply to Office action of October 8, 2003

MPEP 2131 also states that "[t]he identical invention must be shown in as complete detail as is contained in the ... claim." *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989).

Regarding claim 22, Applicant submits that Taenzer does not disclose or suggest at least the limitation of "a flexible eartip for acoustic sealing with an ear canal of a user, the flexible eartip having a foam eartip portion and a flexible tube portion," and the limitation of "a rigid tube nipple providing an acoustic pathway through at least one wall of the housing and having a first end and a second end, the first end of the rigid tube nipple being located within the housing and being acoustically coupled to the output port of the receiver and the second end of the rigid tube nipple being located externally to the housing and being acoustically coupled to flexible tube portion of the flexible eartip" as claimed by Applicant in Claim 22.

In addition, regarding claim 22, Applicant also submits that Taenzer does not disclose or suggest at least the limitation that "the insert earphone is inserted at least partially into the ear canal and is supported entirely by the ear canal when worn by the user" as specifically claimed by Applicant in the amended Claim 22. Taenzer discloses a sound delivery system body (12), which is supported entirely by the outer surface of the ear and not by the ear canal of the user. The body (12), disclosed by Taenzer, is shaped to fit behind an ear (figures 1 and 2, col. 2, lines 51-54). In addition, Taenzer discloses a "ear hook portion 24 of the body 12," where the ear hook portion "extends

Appl. No. 09/676,722  
Amendment dated November 12, 2003  
Reply to Office action of October 8, 2003

from the case portion 22 and curves over the ear of the user,” and it also “supports the body 12 securely on the user’s ear” (figures 1 and 2, col. 3, lines 10-13). The ear hook portion of Taenzer does not fit into the ear canal of the user, nor is the hearing aid supported by the ear canal, as it is contemplated by the present invention.

Based on at least the foregoing, Applicant believes that the rejection of claim 22 in view of Taenzer has been overcome. Furthermore, Applicant asserts that because dependent Claim 23 depends from independent Claim 22, the dependent Claim 23 is also allowable over the cited reference.

Accordingly, Applicant believes the rejections under 35 U.S.C. 102(e) have been overcome and request that the rejections be withdrawn.

**Obviousness Rejection of Claims 1, 3-7, 15-16, and 18-21 under 35 U.S.C. § 103(a)  
Taenzer et al.**

With regard to an obviousness rejection, MPEP 2142 states that in order for a *prima facie* case of obviousness to be established, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. Further, MPEP 2143.01 states that “the

Appl. No. 09/676,722  
Amendment dated November 12, 2003  
Reply to Office action of October 8, 2003

mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art suggests the desirability of the combination,” and that “although a prior art device ‘may be capable of being modified to run the way the apparatus is claimed, there must be a suggestion or motivation in the reference to do so’” (citing *In re Mills*, 916 F.2d 680, 16 USPQ 2d 1430 (Fed. Cir. 1990)). Moreover, MPEP 2143.01 also states that the level of ordinary skill in the art cannot be relied upon to provide the suggestion...,” citing *Al-Site Corp. v. VSI Int’l Inc.*, 174 F.3d 1308, 50 USPQ 2d 1161 (Fed. Cir. 1999).

With regard to the third criterion stated above and in reference to independent Claims 1, Applicant submits that Taenzer does not disclose or suggest at least the limitation of “a flexible eartip for acoustic sealing with an ear canal of a user,” as well as the limitation of “a tube nipple providing an acoustic pathway through at least one wall of the housing and having a first end and a second end, the first end being located within the housing and being acoustically coupled to the output port of the receiver and the second end being located externally to the housing and being acoustically coupled to the flexible eartip, the tube nipple and housing being configured and arranged to form an obtuse angle between a longitudinal axis of the tube nipple and a vertical axis of the housing, wherein the housing hangs approximately vertically along the side of a user’s head when worn.”

Appl. No. 09/676,722  
Amendment dated November 12, 2003  
Reply to Office action of October 8, 2003

Similarly, in reference to independent Claims 15, Applicant submits that Taenzer does not disclose or suggest at least the limitation of "a flexible eartip for acoustic sealing with ear canal of a user," as well as the limitation of "a tube nipple having a first end and a second end, the first end located within the housing and acoustically coupled to the output port of the receiver and the second end located externally to the housing and acoustically coupled to the flexible eartip."

Furthermore, regarding independent Claims 1 and 15, Applicant submits that Taenzer does not disclose or suggest at least the limitation that "the insert earphone is inserted at least partially into the ear canal and is supported entirely by the ear canal when worn by the user" as specifically claimed by Applicant in the amended Claims 1 and 15.

With regard to the first criterion stated above, Applicant submits that there is no suggestion and motivation in Taenzer to modify its teachings as necessary to achieve Applicant's claimed invention. In addition, a person of ordinary skill in the art would never look to the Taenzer reference for assistance in designing an insert earphone. Specifically, Taenzer discloses a body (12) that is shaped to fit behind an ear (figures 1 and 2, col. 2, lines 51-54). In addition, Taenzer discloses a "ear hook portion 24 of the body 12," where the ear hook portion "extends from the case portion 22 and curves over the ear of the user," and it also "supports the body 12 securely on the user's ear" (figures 1 and 2, col. 3, lines 10-13). The ear hook portion of Taenzer does not fit into

Appl. No. 09/676,722  
Amendment dated November 12, 2003  
Reply to Office action of October 8, 2003

the ear canal of the user, nor is the hearing aid supported by the ear canal, as is contemplated by the present invention.

Regarding Claims 6 and 15, the prior art cited by the Examiner, taken alone or in combination, does not disclose or suggest at least "an acoustic damper." Applicant is not claiming an acoustic damper per se, but is claiming a unique combination of elements with associated limitations. Applicant respectfully submits that an acoustic damper is not well known when taken in conjunction with the other limitations of Applicant's Claims 1 and 6. Furthermore, if the Examiner believes that using an acoustic damper in the tube of the earphone device is well known (as stated in the Office Action), Applicant respectfully requests that the Examiner cite to prior art evidencing the well-known nature of such use.

Based on at least the foregoing, Applicant believes that the rejection of Claims 1, 6 and 15 in view of Taenzer has been overcome. Furthermore, Applicant asserts that because dependent Claims 3-7, 16, and 18-21 depend from independent Claims 1 and 15, the dependent Claims 3-7, 16, and 18-21 are also allowable over the cited reference.

**Obviousness Rejection of Claims 1 and 22 under 35 U.S.C. § 103(a) - Schiess**

With regard to the third criterion stated above and in reference to independent Claims 1, Applicant submits that Schiess does not disclose or suggest at least the

Appl. No. 09/676,722  
Amendment dated November 12, 2003  
Reply to Office action of October 8, 2003

limitation of "a flexible eartip for acoustic sealing with an ear canal of a user," as well as the limitation of "a tube nipple providing an acoustic pathway through at least one wall of the housing and having a first end and a second end, the first end being located within the housing and being acoustically coupled to the output port of the receiver and the second end being located externally to the housing and being acoustically coupled to the flexible eartip, the tube nipple and housing being configured and arranged to form an obtuse angle between a longitudinal axis of the tube nipple and a vertical axis of the housing, wherein the housing hangs approximately vertically along the side of a user's head when worn" as claimed by Applicant in Claim 1.

Regarding claim 22, Applicant submits that Schiess does not disclose or suggest at least the limitation of "a flexible eartip for acoustic sealing with an ear canal of a user, the flexible eartip having a foam eartip portion and a flexible tube portion," as well as the limitation of "a rigid tube nipple providing an acoustic pathway through at least one wall of the housing and having a first end and a second end, the first end of the rigid tube nipple being located within the housing and being acoustically coupled to the output port of the receiver and the second end of the rigid tube nipple being located externally to the housing and being acoustically coupled to flexible tube portion of the flexible eartip" as claimed by Applicant in Claim 22. The Office Action states that the Schiess reference fails to specifically disclose the eartip as being flexible, but states that it would have been obvious to one of the ordinary skill in the art to modify the eartip

Appl. No. 09/676,722  
Amendment dated November 12, 2003  
Reply to Office action of October 8, 2003

by providing a flexible eartip. However, as mentioned above, there must be some suggestion or motivation, in the prior art, to modify the teachings as the Examiner has done. Applicant submits that Schiess actually teaches away from using a flexible eartip. Specifically, Schiess states :

"The coupler (28) is arranged inside the duct so that it can pivot to all sides via a ball joint. Such an arrangement makes possible an individual alignment of the coupler (28) in the direction of the sound conduit (24) leading to the eardrum. The sound conduit (24) is located inside a projection (22) of an otoplastic (12), in which the housing (10) is embedded."

Schiess further states:

"Such an otoplastic is produced according to a mold of the auricle and the auditory canal. The otoplastic has a projection in which the sound conduit is guided toward the eardrum into the auditory canal."

The otoplastic is obviously custom-molded to fit the user's auricle and auditory canal. Schiess acknowledges that "a highly bent sound conduit can be disadvantageous, not only with respect to the mounting, but also with respect to the transmission of sound." Thus, a flexible eartip, as claimed by Applicant, is clearly not contemplated by the Schiess device, where the projection (22) that contains the sound conduit (24) is made of otoplastic. A person of ordinary skill in the art, therefore, would never look to modify the Schiess device to achieve Applicant's claim limitation of a "flexible eartip." Applicant further respectfully submits that a flexible eartip is not well known when taken in conjunction with the other limitations of Applicant's Claims 1 and 22. Furthermore, if the Examiner believes that using a flexible eartip in an earphone device is well known



Appl. No. 09/676,722  
Amendment dated November 12, 2003  
Reply to Office action of October 8, 2003

(as stated in the Office Action), Applicant respectfully requests that the Examiner cite to prior art evidencing the well-known nature of such use.

Similarly, regarding Claims 1 and 22, Applicant submits that Schiess does not disclose or suggest at least the limitation that "the insert earphone is inserted at least partially into the ear canal and is supported entirely by the ear canal when worn by the user" as specifically claimed by Applicant in the amended Claims 1 and 22. The Schiess device is not entirely supported by the ear canal of the user. As evidenced by the Schiess application, the device housing is made of otoplastics and is custom-molded to fit the user's auricle, so at least a substantial part of the Schiess device is supported by the user's ear auricle and not entirely by the user's ear canal.

Based on at least the foregoing, Applicant believes that the rejection of independent Claims 1 and 22 in view of Schiess has been overcome.

Accordingly, Applicant believes that all claim rejections under 35 U.S.C. 103 have been overcome and request that the rejections be withdrawn.

#### **Claims 8-14**

Applicant acknowledges with appreciation the Examiner's allowance of claims 8-14. Applicant has made a minor amendment of Claims 8-14 by deleting "rigid" in reference to "tube nipple."

Appl. No. 09/676,722  
Amendment dated November 12, 2003  
Reply to Office action of October 8, 2003

#### **New Claims 24-34**

Applicant acknowledges with appreciation the Examiner's statement that Claims 2 and 17 would be allowable if rewritten in independent form including all of the limitations of the base claims and any intervening claims. Applicant has submitted new Claims 24-34. Independent Claims 24 and 30 correspond, respectively, to Claims 2 and 17 prior to this amendment, but rewritten in independent form. Dependent Claims 25-29, and 31-34 depend from Claims 24 and 30. Applicant, therefore, believes that all new Claims 24-34 are in condition for allowance.

Appl. No. 09/676,722  
Amendment dated November 12, 2003  
Reply to Office action of October 8, 2003

**CONCLUSION**

Based on at least the foregoing, Applicant believes that all claims 1-34 are in condition for allowance. If the Examiner disagrees, Applicant respectfully requests a phone interview, and requests that the Examiner telephone the undersigned at 312-775-8000.

The Commissioner is hereby authorized to charge any additional fees or credit any overpayment to the deposit account of McAndrews, Held & Malloy, Ltd., Account No. 13-0017.

A Notice of Allowability is courteously solicited.

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'C. Winslade', written over a horizontal line.

Christopher C. Winslade  
Reg. No. 36,308  
Attorney for Applicant

Date: November 12, 2003

McAndrews, Held & Malloy, Ltd.  
500 West Madison Street, 34th Floor  
Chicago, Illinois 60661  
(312) 775-8000